

### **REMARKS**

This responds to the Office Action mailed on October 5, 2005, and the references cited therewith. Claims 1 and 18 are amended, claims 50-91 are canceled, and claims 92-93 are added. Claims 1-49 and 92-93 are pending in this application.

#### **Affirmation of Election**

Restriction to one of the following claims was required:

- I. Claims 1-49, drawn to a process of making, classified in class 438, subclass 253.
- II. Claims 50-91, drawn to product/product-by-process, classified in class 257, subclass 306.

As provisionally elected by Applicant's representative, Tim Clise, on July 26, 2005, Applicant elects to prosecute the invention of Group I, claims 1-49. The claims of the non-elected invention, claims 50-90, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

#### **§112 Rejection of the Claims**

Claims 18-22 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 18 to overcome the rejection. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph, be withdrawn.

#### **§102 Rejection of the Claims**

Claims 1, 3, and 4 were rejected under 35 U.S.C. § 102(b) for anticipation by Matsuki (U.S. 6,121,083). Applicant has amended claim 1.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990)

(en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because the reference does not teach each and every claim element. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Among the differences, claim 1, as amended, recites “a distance between the side of the first memory container and the side of the second memory container is S, [and] a distance between the corner of the first memory container and the corner of the third memory container is L, and wherein the distance L is greater than the distance S. The Office indicated that Matsuki in Figures 8A-8D and accompanying text (at column 10, line 61 – column 11, line 34) discloses the limitations of claim 1. Applicant respectfully submits that these sections of Matsuki do not disclose the distances between the memory containers (as cited above).

Accordingly, because the cited reference does not disclose all of the claim limitations, Applicants respectfully submit that the rejection of claim 1 under 35 U.S.C. §102 has been overcome. Claims 3 and 4 depend from claim 1 and distinguish the reference for at least the same reason.

#### §103 Rejection of the Claims

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsuki in view of Nagel et al. (U.S. 5,994,153). Because claims 5 and 6 depend from and further define claim 1, the rejection of claims 5 and 6 under 35 U.S.C. §103 has been overcome.

*Allowable Subject Matter*

Applicant acknowledges the allowance of claims 7-17 and 24-29 and the allowability of claims 2 and 18-23. The Office indicated statements for reasons of allowance/allowability. Applicant submits that these reasons makes numerous assertions regarding the interpretations of limitations of the claims, the contents of the art and distinguishing features of the claims. Applicant has neither verified nor accepted the accuracy of these assertions, and respectfully submits that there may be different interpretations that those identified in these statements. Additionally, Applicant respectfully submits that the relevant claims may be allowable for one or more reasons in addition to and/or in alternative to those reasons identified in these statements. Applicant reserves the right to further address one or more aspects of these statements as may later be necessary or desirable.

*New Claims*

Applicant has added new claims 92 and 93. Applicant submits that no new matter has been added and that claim 92 is at least supported by the description of Figure 2B. Applicant submits that claim 93 is claim 2 rewritten in independent form, which was considered “allowable if rewritten in independent form . . .” Office Action at ¶13.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

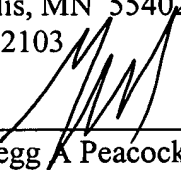
Respectfully submitted,

KEVIN TOREK ET AL.


By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 371-2103

Date 2-6-06

By   
Gregg A. Peacock  
Reg. No. 45,001

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 6 day of February, 2006.

  
Name

  
Signature